

REMARKS

By the foregoing Amendment, Applicants has amended independent Claim 1 to make it clear that the polymer of the balance layer consists of a thermoplastic polymer. However, Applicants has “broadened” Claim 1 by deleting the requirement that it have a dampening foil arranged between the upper side of the core and the abrasion resistance thermosetting laminate. However, such subject matter is recaptured in new dependent Claim 63.

The previously withdrawn claims have been cancelled, but Applicants expressly reserve their rights to file divisional application(s) claiming the benefits afforded by 35 U.S.C. 119, 120 and 121. A typographical correction(s) has been made to dependent Claim 32 as well as 36 and new Claims 59-63 have been added. Support for new Claims 59-62 can be found in the original disclosure, for example, in the paragraph bridging pages 1-2 in the Specification as well as paragraphs 2 and 3 on third page of the Specification. Accordingly, the foregoing Amendment does not raise the issue of new matter.

Reconsideration of the previous objection to Claim 32 is requested in view of the foregoing Amendment which corrects the typographical errors in the term “by at”.

The Examiner is correct in presuming that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made and thus no further response is required.

Reconsideration of the previous rejection of Claims 1, 2, 4, 10-12, 14-17, 30-32 and 37-55 under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of any one of Mason (U.S. Patent No. 1,995,264), Berry et al. (U.S. Patent No. 4, 406,455), or Karam (U.S. Patent No. 6,485,823) and Moebus (WO 01/21366 and see also English equivalent U.S. Patent 6,761,961). Initially, Applicants point out that U.S. Patent 6,761,961 is not a reference under any applicable section of 35 U.S.C. 102 and thus cannot be used in a rejection of 35 U.S.C. 103(a).

This Patent is not a reference under 35 U.S.C. 102(e) because the International Application was not published in English as is clear from the citation of WO 01/21366 which was published in German.

Furthermore, there is no evidence to support the Examiner's conjecture that U.S. Patent No. 6,761,961 is the English language equivalent of the cited Moebus WO 01/21366 and even if it is, it is still not citable in a rejection under 35 U.S.C. 103(a) since it is not "prior art" under 35 U.S.C. 102. Accordingly, the Applicants respectfully request withdrawal of the citation of U.S. Patent No. 6,761,961 as not being "prior art" and hence not citable in this rejection.

Notwithstanding the foregoing Remarks, Applicants respectfully submit that the proposed combination of references does not establish a *prima facie* case of obviousness for the claimed invention.

The Examiners' reasonings appears to be that any one of Mason, Berry et al., Karam or Moebus disclose a method of manufacturing a floor covering having upper and lower layers identical/symmetrical on opposite sides of a core. Unless it would be presumed by the Examiner that one skilled in the art would want to make the Sjoberg et al. upper layer balanced by a symmetrical lower layer, such that the upper and lower layers on opposite sides of the core are identical/symmetrical, would the rejection make any sense. However, even if such were to be achieved that is not the claimed invention.

Rather, Applicants have an asymmetrical upper and lower layer on opposite sides of a core.

This is now emphasized in amended Claim 1 which specifically states that the upper side of the core is provided with the abrasion resistance thermosetting laminate and that the lower side of the core consists of a balance layer... said balance layer comprising a layer of polymer, said polymer consisting of a thermoplastic polymer...".

Thus, it can be seen that unlike the alleged teachings of all the cited prior art which tends to mimic or duplicate the upper and lower surfaces, Applicants here purposefully use a thermosetting resin on the upper side and a thermoplastic polymer on the lower side of the core. Thus, the claimed invention cannot not possibly be obvious in view of the Examiner's reasoning that one skilled in the art would want to mimic or duplicate the materials on both the upper and lower side of a core material. For all the foregoing reasons Applicants respectfully submit that independent Claim 1 cannot possibly be obvious over any combination of the cited references.

Although Applicants have removed the recitation of a dampening layer from independent Claim 1 (although recouping this subject matter in new dependent Claims 63), Applicants respectfully submit that a dampening foil of an elastomer arranged between the upper side of the core and abrasion resistance thermosetting laminate further removes Claim 63 from the proposed combination of references.

Not only does this additional asymmetric layer further remove the claimed invention from the cited references, which tend to duplicate or mimic the structure of the upper layer in the lower layer, but Applicants' balance layer comprises a polymer which polymer consists of a thermoplastic in contrast to the combination of a thermosetting laminate layer and a dampening foil of an elastomer. Accordingly, Applicants respectfully submit that new Claim 63 (and claims dependent thereon) are also unobvious over the proposed combination of references. Withdrawal of the rejection is therefore respectfully requested.

Reconsideration of the previous rejection of Claims 24 -26, 29 and 33-36 under 35 U.S.C. 103(a) as being unpatentable over any of the references cited above as applied to the claims discussed above, and further in view of Leukel et al. (U.S. Patent No. 4,770,916) is respectfully requested. As the references do not establish a *prima facie* case of obviousness for independent Claim 1, the claims dependent thereon are also patentable.

Applicants further wish to point out that such conductive material as claimed in Claims 24-26, 29 are contained in the balance layer and there is no teaching of such a conductive layer in a balance layer comprising a polymer which polymer consists of a thermoplastic polymer as instantly claimed. As to Claims 33-36 it is the glue which comprises a conductive material, which glue is clearly distinguished from the balance layer of Claims 24-26 and 29. Accordingly, Applicants respectfully submit that the further combination including the citing Leukel et al. reference does not establish a *prima facie* case of obviousness for these claims. Withdrawal of the rejection is therefore respectfully requested.

Reconsideration and withdrawal of the previous rejection of Claims 24 and 27-29 under 35 U.S.C. 103(a) as being unpatentable over the references applied to Claim 1 above and further

in view of Nowell et al. (U.S. Patent No. 4,885,659) is requested as it also does not establish a *prima facie* case of obviousness for the claimed invention.

The deficiencies of the basic rejections as applied to Claim 1 is set forth above and thus these claims, dependent upon Claim 1 are also patentable. In addition, Applicants wish to point out that it is the balance layer of dependent Claim 24 which comprises a conductive material by contrast Nowell et al. do not describe a thermosetting laminate affixed to a core as an upper surface and a lower surface comprising a thermoplastic layer. All that is taught in Nowell is that a static dissipative surface covering material can be formed by vacuum aluminum coating a glass fiber tissue material disposed in or near the thermoplastic layer of his floormat to provide the static dissipative surface covering material. There is no teaching of the combination as instantly claimed in Claims 24 and 27-29 that would have lead one skilled in the art to correct the foregoing deficiencies of Sjoberg in view of any one of Mason, Berry, et al., Karam or Moebus when viewing of Nowell teaching. In fact, to further create asymmetry in Sjoberg, et al. teaching in view of the secondary references is anathema to the rejection that symmetry should be duplicated on each side of the core in view of the secondary references. Accordingly, Applicants respectfully submit that Nowell et al., even in view of combination with the other references, does not establish a *prima facie* case of obviousness for the claimed invention and withdrawal of the rejections is respectfully requested.

In response to the obviousness-typed double patenting rejections as set forth in paragraphs 9, 10 and 11 of the preceding Office Action Applicants herewith file a Terminal Disclaimer to obviate such rejections.

However, Applicants respectfully traverse the provisional non-statutory obviousness-type double patenting rejections set forth in paragraphs 12, 13 and 14 as being premature. As no claims have been allowed in either of the applications (*i.e.* the present application or that of co-pending application 11/129,497) the final form of the claims is not yet fixed and thus there is no reason to believe that the claims will still present an obviousness-typed double patenting when in the final, allowable form. Furthermore, as the prosecution of this application is further along and that of co-pending application 11/129,497 it is respectfully requested that the present claims be

permitted to issue and any consideration of a Terminal Disclaimer will be made in such co-pending application if required in the future.

Having fully responded to the preceding Office Action favorable reconsideration withdrawal of all rejections and passage of the application to issue are respectfully requested. If any additional fee is necessary to make this paper timely and/or complete, it may be charged to the undersigned's **deposit account number 19-4375**.

Respectfully submitted,



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